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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,295	11/13/2001	Linda Ann Roberts	BELL-0130/01183	2697

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/008,295

Applicant(s)  
Roberts et al

Examiner  
Steven McAllister

Art Unit  
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 26, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 7 and 12 recite providing a shopper with an option to supply notification information. However, the specification describes providing notification information comprising delivery address and telephone number as part of an attempt to purchase and not as an option (pg. 5, lines 16-18).

In applying prior art to the claims, it was assumed that the claims intend to claim providing the option of providing notification information independent of delivery information.

### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 12-15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Suzuki et al (6,470,323).

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Regarding claim 12, Suzuki shows a server 1 with an interface connected to a network 2 (see Fig. 1). It inherently shows a process engine capable of receiving purchasing and notification information, and recognizing a triggering event since the server of Suzuki accomplishes those functions and a computer system cannot do so without a processing engine. It is noted that such a processing engine is capable of providing a shopper with an option to supply notification information.

Alternatively, claim 12 shows all elements of the claim except that the processing engine is capable of providing a shopper with an option to supply notification information. However, it is notoriously old and well known in the art to do so. One of ordinary skill in the art would use a processing engine capable of providing an option to the user to provide contact information in order to protect customer privacy and in order to avoid losing sales to customers who are unwilling to provide mandatory contact information.

As to claim 13, Suzuki shows a data storage facility in communication with the processing engine that stores data. It is inherent that it stores the notification information since the system notifies the customer when goods arrive and it must have notification information to do so.

As to claim 14, it is noted that Suzuki contains a shopper profile comprising the customer utilization history associated with the electronic request and operatively associated with customer notification information as described regarding claim 13.

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As to claim 15, it is inherent that Suzuki has a message routing agent adapted to receive notification information since the system routes customer messages and must receive notification information to do so.

*Claim Rejections - 35 USC § 103*

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (6,470,323).

Suzuki shows receiving electronic purchasing information from a shopper via a network 2 containing an electronic request to purchase goods. It inherently shows providing notification information since the customer is later contacted by the system. Suzuki also shows recognizing the occurrence of a triggering event that affects the performance of the electronic request comprising the arrival of merchandise that was out of stock. It further shows notifying the shopper of the triggering event via the communication pathway. Suzuki does not show that the notification information is provided optionally. However, it is notoriously old and well known in the art to provide the option for a customer to provide notification information that is not required. For instance, often an email address or telephone number is only an optional field when purchasing goods. It would have been obvious to one of ordinary skill in the art to provide the customer with an option of providing notification information in order to protect customer

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privacy and in order to avoid losing sales to customers who are unwilling to provide mandatory contact information.

Regarding claim 7, it is noted that system of Suzuki in view of the well known prior art shows all elements of the claim.

6. Claims 2, 3, 6, 8, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (6,470,323) in view of Roberts et al (6,101,486).

Suzuki shows, in addition to the elements of claim 1, a customer profile associated with the electronic request. It further inherently shows accessing notification information since it shows contacting the shopper. It does not explicitly show that the notification information is associated with the shopper profile. Roberts shows a customer profile with notification comprising an email address. It would have been obvious to one of ordinary skill in the art to modify the method of Suzuki by associating an email address as taught by Roberts with the customer profile to allow automated contact via the internet.

7. Claims 4, 5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al (6,470,323) in view of "Presence: the Best Thing That Ever Happened to Voice" (hereafter Presence).

As to claims 4 and 10, Suzuki shows all elements of the claim except notification information comprising presence information. Presence shows notification information

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comprising presence information. It would have been obvious to one of ordinary skill in the art to modify the method of Suzuki by using presence information in order to determine how the person would prefer to be contacted, therefor creating greater customer satisfaction.

As to claims 5 and 11, it is noted that Suzuki in view of Presence shows notification information representative of a plurality of pathways with each having a preferred rank (see second paragraph of page 1 of Presence).

#### *Response to Arguments*

8. Applicant's arguments filed 7/25/03 have been fully considered but they are moot due to the new rejection.

The Applicant argues that Suzuki does not show providing an option to supply contact information. The examiner agrees. However, as shown above in the modified rejection, it is old and well known to provide a user with an option regarding information such as email address or telephone number.

Regarding Applicant's argument that Suzuki does not show alternative communication paths, it is noted that this is shown via the teaching references above.

Applicant also argues that because the message of Suzuki are sent automatically there is no motivation to provide the option whether provide contact information. The examiner respectfully disagrees. Suzuki et al deal with a commercial website which sells products or

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services. Additionally, it sends out messages regarding backordered items when they arrive and targeted advertisements. As stated above, a motivation does exist. First, to protect customers' privacy. Many customers are not comfortable providing telephone numbers or email addresses and receiving advertisements as a result of having had to provide that information offends many customers. Similarly, some customers may choose to abort a proposed purchase entirely to avoid providing such information. So, protecting customers' privacy (and keeping their good will) and avoiding the loss of sales is a motivation.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052.

A handwritten signature in black ink, appearing to read "St B. McAllister".

Steven B. McAllister

September 27, 2003